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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,886	03/12/2004	Tadatoshi Suzuki	70456-020	4901

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EXAMINER	
HANNON, THOMAS R	
ART UNIT	PAPER NUMBER
3682	

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/798,886	SUZUKI ET AL.	
	Examiner	Art Unit	
	Thomas R. Hannon	3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-9 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-9 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 12 March 2004 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 3/12/04.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Ohki 2003/0123769

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the

inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claims 1 and 3 are rejected under 35 U.S.C. 102(e) as being anticipated by Murakami et al. 6,699,335.

The component of Murakami '335 relates to bearings, which is a component of a crank mechanism. Murakami '335 teaches a component having a hydrogen content of no more than 0.5 ppm. (Table I). With respect to claim 3, there is reason t believe, based on the similarity of material, that the functional limitation(s) of fracture stress value may be (an) inherent characteristic(s) of Murakami's steel. In accordance with In re Best, 562 F.2d 1252, 195 USPQ 430, 433 (CCPA 1977):

> [W]here the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

This "burden of rebutting [may be of] the PTO's reasonable assertion of inherency under 35 USC 102, or a prima facie obviousness under 35 USC 103" (195 USPQ at 432).

Accordingly, the burden is placed upon the applicant o prove that the limitation in question is not (an) inherent characteristic(s) of the reference disclosure.

Claims 2 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Takemura et al. 6,224,688. Takemura '688 discloses a rolling bearing (i.e., a component of a crank mechanism) wherein the bearing contains austenite grain size number exceeding 10 (column 5, line 59).

With respect to claim 3, there is reason t believe, based on the similarity of material, that the functional limitation(s) of fracture stress value may be (an) inherent characteristic(s) of Murakami's steel. In accordance with In re Best, 562 F.2d 1252, 195 USPQ 430, 433 (CCPA 1977):

> [W]here the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

This "burden of rebutting [may be of] the PTO's reasonable assertion of inherency under 35 USC 102, or a prima facie obviousness under 35 USC 103" (195 USPQ at 432).

Accordingly, the burden is placed upon the applicant o prove that the limitation in question is not (an) inherent characteristic(s) of the reference disclosure.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4, 5, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami et al.'335 as applied to claims 1 and 3 above, and further in view of Fujiwara et al. Fujiwara discloses a ball bearing assembly (1) including an inner member (2), an outer member (3) and a plurality of rolling elements (4) in a support structure of a crank mechanism that converts reciprocating motion of a piston to rotary motion by means of a crank pin, a crank arm and a crank shaft via a connecting bar (B). It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Murakami et al. '335 in

known devices, including that of a crank support structure, because Murakami discloses the teaching is applicable to machine parts undergoing repetitive high stresses, including bearings, and because Fujiwara teaches a bearing for a crank mechanism in which the bearing material and treatment are shown to be factors in determining the life of the bearing with respect to wear, heat and corrosion resistances.

Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takemura et al. '688 as applied to claims 2 and 3 above, and further in view of Fujiwara et al. 6,290,398.

Fujiwara discloses a ball bearing assembly (1) including an inner member (2), an outer member (3) and a plurality of rolling elements (4) in a support structure of a crank mechanism that converts reciprocating motion of a piston to rotary motion by means of a crank pin, a crank arm and a crank shaft via a connecting bar (B). It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Takemura et al. '688 in known devices, including that of a crank support structure, because Fujiwara teaches a bearing for a crank mechanism in which the bearing material and treatment are shown to be factors in determining the life of the bearing with respect to wear, heat and corrosion resistances.

Fujiwara discloses a ball bearing assembly (1) including an inner member (2), an outer member (3) and a plurality of rolling elements (4) in a support structure of a crank mechanism that converts reciprocating motion of a piston to rotary motion by means of a crank pin, a crank arm and a crank shaft via a connecting bar (B). It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Murakami et al. '335 in known devices, including that of a crank support structure, because Murakami discloses the teaching is applicable to machine parts undergoing repetitive high stresses, including bearings,

and because Fujiwara teaches a bearing for a crank mechanism in which the bearing material and treatment are shown to be factors in determining the life of the bearing with respect to wear, heat and corrosion resistances.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas R. Hannon whose telephone number is (571) 272-7104. The examiner can normally be reached on Monday-Thursday (8:30-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571) 272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thomas R. Hannon
Primary Examiner
Art Unit 3682

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